

REMARKS

I. Status of the Application

Claims 1, 3-6, 11-12, 15, 17-20, 25-26, 29, 31-34, 39-40, 43, 45-48, and 53-54 are pending.

II. Rejections

a. 35 U.S.C. 112

In the previous Office Action, the Examiner rejected claims 11, 25, 39, and 53 under 35 U.S.C. 112 as failing to comply with the written description requirement. The Examiner alleges that “canceling the selected bid or offer for the third item simultaneously with the shift of the price for the selected bids or offers” does not have support in the original disclosure. Applicants disagree. Support may be found at page 3, lines 1-10, which states:

Furthermore, the present invention may provide users with multiple bid/offer interactions. For example, a user may choose to simultaneously shift a price or a size of a plurality of bids and/or offers, simultaneously cancel a plurality of bids and/or offers, or simultaneously suspend and/or make active a plurality of bids and/or offers. The ability to apply changes to a plurality of bids and/or offers simultaneously may provide the user with time efficient bid/offer shifting.

From this passage (last sentence), it is understood that various changes to a plurality of bids and/or offers may be applied simultaneously. Changes that may be performed simultaneously include price shifts, cancellations, and/or status changes, which fully supports cancelling a bid or offer (the third) while at the same time shifting

the price of other bids and/or offers (the first and second). In his response, the Examiner focuses on the “or” in the second sentence of the passage. The second sentence only provides a list of example combinations. The last sentence indicates that any combination of changes may be applied simultaneously. Accordingly, withdrawal of the rejection is respectfully requested.

b. 35 U.S.C. 102 and 103

The pending claims were rejected either under 35 U.S.C. 102 as being anticipated by Ojha et al. (U.S. Patent 6598026) or under 35 U.S.C. 103 as being unpatentable over Ojha in view of at least one of Buist (U.S. Patent 6408282). Applicants respectfully traverse.

With regard to claims 1, 29, 15, and 43, the Examiner asserts that Ojha discloses an interface screen comprising a listing of a plurality of bids and offers received from the user each individually selectable for the user to select multiple of the plurality of bids and offers at figs. 9 and 11. The Examiner is mistaken. First, the Ojha interface in Fig. 9 is a buyer interface that includes a list of bids only and Fig. 11 is a Merchant interface that includes a list of offers only. Ojha does not disclose an interface that combines bids and offers for a user in a single interface. Second, there is no discussion whatsoever in Ojha and it is not apparent from the Figs. alone that the listed bids and offers are individually selectable for the user to select multiple of the plurality of bids and offers, as claimed. As such, Ojha does not disclose shifting the price of the selected bids or offers simultaneously.

With regard to claims 4, 6, 11-12, 15, 17-19, 25-26, 32, 34, 39-40, 43, 45-47 and 53-54, the Examiner asserts motivations to combine the cited references without any support for those assertions. In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings, there must be a reasonable expectation of success, and the prior art references must teach or suggest all of the claim elements. (In re Vaeck, 947 F.2d 488, 493 (Fed. Cir. 1991)). The suggestion or motivation proffered by the Examiner to modify a reference must be supported with substantial factual evidence in the record. (In re Lee, 277 F.3d 1338, 1342 (Fed. Cir. 2002); In re Zurko, 258 F.3d 1379, 1383-1386 (Fed. Cir. 2001); Novamedix Distrib., 175 F. Supp. 2d 8, 9 (D.D.C. 2001)). A conclusory or common sense statement as to the factual question of motivation must be supported by evidence in the record and without such evidence, the statement lacks substantial evidence support and is thereby insufficient to establish a *prima facie* case of obviousness. In re Lee, 277 F.3d at 1343-1345 (“[C]onclusory statements ... do not adequately address the issue of motivation to combine. ... [The] factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority.”); In re Zurko, 258 F.3d at 1385 (“This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support.”).

As in In re Lee, the Examiner merely recites conclusory statements regarding the motivation to combine the references without any objective evidence supporting these statements. Moreover, the Examiner is silent with regard to the expectation of success. The Examiner has therefore failed to establish a *prima facie* case of obviousness with regard to at least claims 4, 11-12, 15, 32, and 39-40. Applicants demand that the Examiner provide a reference for the proffered motivation if the rejections are to be maintained.

Applicants submit that the remaining claims include features that further distinguish Applicants' claimed invention from the art of record. Applicants reserve the right to argue those features at a later time.

III. Conclusion

Reconsideration and allowance of claims are therefore respectfully solicited. To expedite prosecution, the Examiner is invited to contact the Applicant's representative at 212-829-5407.

Respectfully submitted,

February 3, 2009 /Antonio Papageorgiou/

Antonio Papageorgiou
Attorney Reg. No. 53,431
Cantor Fitzgerald LP
110 East 59th Street
New York, NY 10022
(212)-829-5407/phone
(212)-308-7537/fax